

REMARKS

CLAIM AMENDMENTS

Applicant appreciates the Examiner having pointed out that claims 15 and 16 are duplicates. In response, Applicant cancels claim 16.

Applicant amends selected claims to correct minor grammatical errors. No new matter is introduced.

SECTION 102 REJECTION OF CLAIMS 1, 14, AND 17

Katz allegedly teaches the limitations of claim 1 between paragraphs 24-32.

In fact, there is no disclosure in *Katz* of transmitting “a graphical representation” to any customer or driver. In *Katz*, the customer or driver simply receives text, not “a graphical representation”.

Paragraph 24 describes a system that sends the customer “a display with the ‘pickup’ and destination addresses.” *Katz* does not disclose that this information is in any way “a graphical representation.” Thus, although *Katz* teaches sending information to a customer, it does not say that the information is “a graphical representation.”

Applicant is unable to identify any other text in *Katz* that might reasonably be regarded as disclosing “transmitting to a customer or a driver a graphical representation.” Applicant requests that the Office quote verbatim the particular text that is believed to identify the foregoing limitation.

A section 102 rejection requires that a single reference disclose each and every limitation of the claim. In this case, there is at least one limitation missing. In particular, *Katz* does not teach transmitting “a graphical representation” to a customer or driver.

Claims 14 and 17 include limitations similar to claim 1 and are patentable for at least the same reasons.

SECTION 102 REJECTIONS OF CLAIMS 18-20, 15-16, AND 2-4

In rejecting each of the foregoing claims, the Office fails to indicate where *Katz* discloses the additional limitations of that claim. Instead, for each rejection, the Office makes a conclusory statement that that particular limitation is disclosed somewhere in *Katz*.

Applicant submits that the foregoing section 102 rejections are inconsistent with Rule 1.104(c)(2), which states that “[w]hen a reference is complex, or shows or describes inventions other than that claimed by the application, the particular part relied on must be designated as clearly as practicable.”

In view of the foregoing deficiency in the action, Applicant submits that any further Action cannot properly be made final.

In the interest of avoiding unnecessary speculation and promoting efficiency of prosecution, Applicant requests that the Office provide, for each of the foregoing claims, a verbatim quote of the specific language from *Katz* that is believed to disclose the limitation at issue.

SECTION 103 REJECTION OF CLAIMS 5-7, 10, AND 12-13

The Office disregards the additional limitation of each of these claims because these limitations pertain to allegedly non-functional descriptive data. In doing so the Examiner cites *Gurlack*¹ and *Lowry*.²

The Examiner states that there is no functional interrelationship because the “the transportation reservation system/method would be performed regardless of the type of graphical representation displayed to the users.”

This statement is incorrect on its face. The type of graphical representation makes a significant difference to the customer and driver's experience. In particular:

¹ *In re Gulack*, 703 F.2d 138, (CAFC 1983).

² *In re Lowry*, 32 F.3d 1579, (CAFC 1994)

- in claims 5-7, the presence of photographs makes it easier for driver and customer to identify each other and for the passenger to confirm that the vehicle he is boarding is the correct vehicle;
- in claims 12-13, the presence of text messages from either the driver or the customer enables the two to communicate with each other, thereby enabling them to locate each other in, for example, a crowded airport;
- in claim 10, the presence of information identifying an airport enables the driver and customer to know where to meet.

Thus, the additional limitations offer significant advantages to the users of the system. These advantages arise because of functional interrelationships that the Office alleges are missing. Accordingly, these claim limitations are entitled to patentable weight.

According to *Gurlack*, which the Office itself has cited:

Differences between an invention and the prior art cited against it cannot be ignored merely because those differences reside in the content of the printed matter. Under section 103, the board cannot dissect a claim, excise the printed matter from it, and declare the remaining portion of the mutilated claim to be unpatentable. The claim must be read as a whole.³

In *Gurlack*, the claim recited a band with numbers imprinted thereon according to a special pattern. The prior art recited a hatband with numbers printed thereon, and the only distinction lay in the content of the printed matter.

It is significant that in *Gurlack*, the Court *reversed* the Board and found the claim patentable. In doing so, Court stated that a functional interrelationship existed between the numbers and the band recited in applicant's claim 1 because "the band supports the digits."⁴

³ *Gulack* at 1385.

⁴ *Gulack* at 1386.

Thus, according to the Court in *Gurlack*, numbers imprinted on a band define a “functional interrelationship” between the two sufficient to impart patentable weight to the numbers. This is similar to the claimed subject matter, in which photographs and/or text messages are part of a graphical representation transmitted to a driver or customer.

Moreover, *Gurlack* and *Lowry* both pertain to apparatus claims, not method claims. It is difficult to imagine conceptually how the printed matter doctrine as applied in *Gurlack* and *Lowry* would have any application to method claims.

Accordingly, Applicant submits that the additional limitations of the above claims are entitled to patentable weight.

Having established that the additional limitations are entitled to patentable weight, the next step is to consider the Office's proposed motivation to combine the references.

The Office states that one of ordinary skill in the art would have found it obvious to modify *Katz* for two reasons:

- (1) because photographs and text messages do not “functionally relate to the steps in the method” and
- (2) because “the subjective interpretation of the data does not patentably distinguish the claimed invention.”

As a threshold matter, in both reasons (1) and (2), the Office has assumed that one of ordinary skill in the art would have already *known* the “steps in the method” and “the claimed invention.” However, both “the steps of the method” and “the claimed invention” come from Applicant's own disclosure. As such, they are *not* part of the prior art, and therefore cannot be relied upon as a basis for modifying the reference.

With regard to reason (1), if, as the Office suggests, one of ordinary skill in the art would have known that photographs and text messages do not “functionally relate to the steps in”

applicant's claimed method,⁵ he would have recognized no advantage in doing so. Accordingly, he would have had no reason to modify *Katz* as recited in any of the dependent claims 5-7, 10, and 12-13 since doing so would, in his view, have conferred no advantage. Thus, reason (1) is effectively a reason for why one of ordinary skill in the art would *not* have modified *Katz*.

With regard to reason (2), it is unclear why the patentability or lack thereof of Applicant's claimed invention would have any relevance to whether or not one of ordinary skill in the art would have modified *Katz* to include photographs, text, or location information as recited in the dependent claims. One of ordinary skill in the art would have had no way of knowing "the claimed invention." Applicant's claims were only disclosed in the patent application. They are not part of the prior art. Without knowing "the claimed invention," one of ordinary skill in the art would have had no basis for modifying *Katz* because "the subjective interpretation of the data does not patentably distinguish the claimed invention."

According to *KSR v. Teleflex*, "there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."⁶

The idea proposed in reason (1), namely that one of ordinary skill in the art would have modified *Katz* to include elements that "do not functionally relate" to steps in *Katz*, reads like a reason *not* to modify *Katz*. It hardly amounts to any "articulated reasoning with some rational underpinning" to support an obviousness rejection.

Similarly, the idea proposed in reason (2), namely that one of ordinary skill in the art would have modified *Katz* because Applicant's claims are not patentable makes absolutely no sense and is even more remote from being an "articulated reasoning with some rational underpinning" required by *KSR*.

⁵ A method which, since it is not part of the prior art, one of ordinary skill would have had no reason to know.

⁶ *KSR v. Teleflex* at 127 S.Ct. 1727, 1741

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Accordingly, Applicant requests reconsideration and withdrawal of the section 103 rejections of claims 5-7, 12-13.

SUMMARY

Now pending in this application are claims 1-15 and 17-20. Of these, claims 1, 14, and 17 are independent. No additional fees are believed to be due in connection with the filing of this response. However, to the extent fees are due, or if a refund is forthcoming, please adjust our deposit account 06-1050, referencing attorney docket number 08575-110001."

Respectfully submitted,

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